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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,986	06/30/2003	Eugenio Cruz	5724.016.20-US	9867

7590 09/30/2005

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EXAMINER

ROSSI, JESSICA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary

Application No.

10/607,986

Applicant(s)

CRUZ, EUGENIO

Examiner

Jessica L. Rossi

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/19/04, Prelim. Amd.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/29/05, 5/3/04, 3/19/04, 6/30/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements filed on 7/29/05, 5/3/04, 3/19/04 and 6/30/03 contain many references that are listed more than once. The examiner has crossed-off all duplicates to avoid confusion.

Drawings

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The present application claims priority to application 09/903,807 as set forth in the amendment to the specification dated 6/30/03; however, the '807 application has since issued as US PAT 6,638,387 and therefore Applicant should amend the specification accordingly.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitations set forth in claim 12 are not found in the specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5-6 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Giertz et al. (WO 97/31775).

With respect to claim 1, Giertz is directed to making a decorative laminate. The reference teaches locating a resin soaked paper sheet 1 having a decorative motif (p. 2, 2nd paragraph) on a board 4 (p. 2, last two sentences), placing the decorative sheet and board into a press machine having a press plate with a three dimensional surface (p. 3, 2nd paragraph; p. 6, last sentence – p. 7), curing the resin at a predetermined temperature while pressing the decorative sheet and board with the press at a predetermined pressure such that a laminated product is produced (p. 4, lines 3-5 in 2nd paragraph), wherein the product has a surface texture that is embossed in registration with the decorative motif (p. 3, 2nd-3rd paragraphs).

Regarding claim 5, the reference teaches such (p. 4, lines 3-5 of 2nd paragraph).

Regarding claim 6, the reference teaches a pressure ranging from 5-90 Bar = 5-90 kg/cm² (p. 4, lines 3-5 of 2nd paragraph).

Regarding claim 8, the reference teaches locating a protective overlay 5 on the paper sheet 1 (p. 3, 6th paragraph – p. 4, 1st paragraph; p. 4, last paragraph).

Regarding claim 9, the reference teaches the overlay 5 being impregnated with resin (p. 4, 1st paragraph).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giertz et al. as applied to claim 1 above.

With respect to claim 2, all the limitations were addressed above with respect to claim 1 except milling reference edges on the board and locating the resin soaked sheet on the board such that the decorative motif assumes a predetermined position on the board relative to the reference edges.

Giertz teaches the edges of the paper sheet 1 extending beyond the edges of the board 4, due to the paper sheet being wider than the board, and locating the paper sheet on the board such that the decorative motif assumes a predetermined position relative to the edges of the board (Figure 1; p. 3, 3rd paragraph; p. 5, 1st paragraph). Since the edges of the paper sheet must extend beyond the edges of the board, it would have been obvious to the skilled artisan to cut (= mill) the edges of the board to achieve a width that is less than that of the paper sheet, wherein the cut edges of the board are equated to Applicant's claimed "reference edges."

Regarding claim 3, the reference teaches placing the paper sheet and board into the press machine using the reference edges to locate the decorative motif within the press machine at a predetermined location relative to the press plate (Figure 1; p. 3, 3rd paragraph; p. 5, 1st paragraph).

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Regarding claim 7, selection of a time duration for pressure application would have been within purview of the skilled artisan depending on the materials used.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giertz et al. as applied to claim 1 above, and further in view of Hunter et al. (US 5413834, listed in IDS).

Regarding claim 4, Giertz is silent as to milling a hollow in the surface of the board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to mill a hollow in the bottom surface of the board of Giertz because it is known in the art to mill a hollow in the surface of a board opposite that having a resin soaked decorative paper layer thereon in order to facilitate bending of the board for its intended use, such as a cabinet, as taught by Hunter (column 1, lines 64-68; column 2, lines 4-12; column 5, lines 45-53; column 6, lines 8-13).

10. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giertz et al. as applied to claim 1 above, and further in view of the Admitted Prior Art in the present specification.

Regarding claims 10-11, Giertz is silent as to locating a base layer under the board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to bond a resin-impregnated base layer to the underside of the board, or side of the board opposite to that having the decorative layer thereon, because such is known in the art, as taught by the Admitted Prior Art (p. 6, section [0020]), where the base layer prevents warping of the board.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giertz et al. and the Admitted Prior Art as applied to claim 10 above, and further in view of Cannady et al. (US 3648358).

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Regarding claim 12, Giertiz teaches the decorative sheet being a paper impregnated with a melamine resin (p. 2, 2nd paragraph) but is silent as to the type of paper. Selection of a particular paper would have been within purview of the skilled artisan depending on the desired characteristics. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kraft paper because it is known in the art to impregnate Kraft paper with a melamine resin and use it for a decorative sheet in a decorative laminate, as taught by Cannady (column 3, lines 27-36).

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,638,387. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '387 patent encompass the limitations set forth in the claims of the present application.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom G. Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jessica L. Rossi
Primary Examiner
Art Unit 1733